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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,445	11/14/2003	David Alan Burton	END9-2002-0061US1	9621
45216	7590	08/31/2007		
Kunzler & McKenzie 8 EAST BROADWAY SUITE 600 SALT LAKE CITY, UT 84111			EXAMINER WALTER, CRAIG E	
			ART UNIT 2188	PAPER NUMBER
			MAIL DATE 08/31/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

mn

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/713,445

Applicant(s)

BURTON ET AL.

Examiner

Craig E. Walter

Art Unit

2188

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 21 August 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

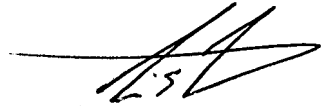
**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
HYUNG SOUGH  
SUPERVISORY PATENT EXAMINER

  
Craig E. Walter  
Examiner Art Unit 2188

Continuation of 11. does NOT place the application in condition for allowance because: In the response filed 21 August 2007, Applicant reasserts arguments previously set forth during prosecution, and further presents rebuttal arguments to Examiner's arguments presented under the heading "Response to Arguments" in the action made FINAL 21 June 2007.

Under the "Remarks" heading of Applicant's After Final response, Applicant discusses alleged deficiencies with Dunham's disclosure at length in paragraphs 0005, 007-0011 and 0013, however fails to address whether or not the previously cited Manley reference teaches any of these alleged deficiencies. In fact, Examiner is unable to locate even a single instance in which Manley's teachings were discussed with respect to the patentability of claim 1 within these paragraphs, notwithstanding the fact that claim 1 was rejected by a combination of both the Dunham and Manley references. Applicant is reminded "[o]ne cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)" pursuant to MPEP § 2145. As such, the arguments set forth under paragraphs 0005, 0007-0011 and 0013 are not persuasive. Examiner further notes that Applicant's arguments set forth in the aforementioned paragraphs are directed to claim 1 (an apparatus claim), in which the alleged deficiencies of Dunham's teachings are related to not structural elements, but their intended function (note the "configured to" language used throughout this claim). Applicant is reminded, "[w]hile features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997)" pursuant to MPEP § 2114.

In paragraphs 0014-0017 Applicant attempts to attack Examiner's previously asserted motivation to combine Dunham and Manley's disclosures. For example in paragraph 0014, Applicant asserts, "Dunham teaches away from an incremental storage system of any type". This argument however is not persuasive, as Examiner previously addressed this argument in the correspondence of record mailed 21 June 2007 (Final Rejection). Applicant continues in paragraph 0015 by contending that Examiner was led to the combination of Dunham and Manley "merely through impermissible hindsight by using Claim 1 as a roadmap to find missing elements". This argument however is not persuasive, as Examiner maintains that motivation to combine Dunham and Manley's teachings was found explicitly within Manley's teachings, hence Examiner did not rely on impermissible hindsight, Applicant's arguments notwithstanding. Under paragraph 0016, Applicant contends, "Suggestion and motivation to combine only makes sense in that an application that is missing an element provide some hint, some direction, something that one of skill in the art can latch onto and be directed to another application containing the missing element to combine the applications", further continuing "[t]he relevant inquiry is not whether a reference contains something that describes an element, but whether or not there is a motivation for making the combination. The Applicants assert that there is not." This argument however is not persuasive. Examiner maintains that the previously asserted prima facie case of obviousness was properly established because the asserted motivation to combine was explicitly extracted from the teaching reference's disclosure, explaining why it would have been obvious to combine the references as a whole (not a particular element from each respective reference) - see Office action mailed 21 June 2007, page 6, lines 6-15. As such, Examiner sufficiently met the requisite burden of establishing a prima facie case of obviousness for these claims, constant with § 103(a) of the Code. Lastly, Applicant reasserts, "Dunham teaches away from an incremental backup." Again, this argument however is not persuasive as Examiner addressed this argument in the correspondence of record mailed 21 June 2007 (Final Rejection). Applicant's arguments that the remaining independent claims are allegedly allowable for similar reasons as claim 1, and that all dependant claims are allowable for further limiting a alleged allowable base claim are rendered moot, as Examiner maintains the rejections to these claims as per the arguments presented in this correspondence, and the arguments and rejections in the Office action made FINAL mailed 21 June 2007.